

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SALMON PIENAAR

Appeal No. 96-2302
Application 08/260,058¹

ON BRIEF

Before COHEN, LYDDANE and CRAWFORD, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to
allow claims 9 through 11, as amended subsequent to the final
rejection. In the answer (page 1), the examiner indicated that

¹ Application for patent June 15, 1994. According to appellant, this application is a continuation of Application 08/013,302, filed February 4, 1993, now abandoned.

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claims 10 and 11 are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 14 through 17 stand allowed. Claims 19 through 34, the only other claims remaining in the application, stand withdrawn from consideration by the examiner pursuant to 37 CFR § 1.142(b). Based upon the above, the sole claim under rejection and for review on appeal is claim 9.

Appellant's invention pertains to a frame structure suitable for packing vehicle bodies into a transport container.

Claim 9 addresses a frame structure comprising, inter alia, a base, a vehicle support means which comprises a lower vehicle support member and an upper vehicle support member, the members being mounted across the base in a horizontally and vertically spaced relationship relative to each other, the lower vehicle support member being relatively close to the base in use to support a lower end of a first vehicle body, and the upper vehicle support member being relatively high from the base in use to support an upper end of the first vehicle body, and attachment means for securing the first vehicle body to both the upper support member and the lower support member.

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In rejecting appellant's claims under 35 U.S.C.
§ 102(e), the examiner has relied upon the reference listed
below:

Preller et al.	5,213,458	May 25, 1993
(Preller)	(effective filing date July 27, 1990)	

The following rejection is the sole rejection on
appeal.

Claim 9 stands rejected under 35 U.S.C. § 102(e) as
being anticipated by Preller.

The full text of the examiner's rejection and response
to the argument presented by appellant appears in the answer
(Paper No. 19), while the complete statement of appellant's
argument can be found in the brief (Paper No. 18).

OPINION

In reaching our conclusion on the anticipation issue
raised in this appeal, this panel of the board has carefully
considered appellant's specification and claims, the applied
reference, and the respective viewpoints of appellant and the
examiner. As a consequence of our review, we make the
determination which follows.

We do not sustain the examiner's rejection of appellant's claim as being anticipated by the Preller patent.

This panel of the board is in accord with appellant's viewpoint that the "attachment means for securing" recitation of claim 9 is a sixth paragraph (35 U.S.C. § 112) means recitation that must be construed to cover the corresponding structure described in the specification and equivalents thereof. See In re Donaldson, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994).

With the above in mind, we understand the aforementioned means plus function recitation to cover the described (specification, pages 2 and 5) two attachment members 13.1 (one shown in Figure 1), each with one or more brackets for securing a (first) vehicle body thereto. The attachment members secure the first vehicle body to both the upper support member (12.4) and the lower support member (12.3).

A review of the Preller patent reveals to us that this document fails to address two attachment members, each with one or more brackets for securing a first vehicle thereto, the attachment members respectively securing the first vehicle body

to both an upper support member and a lower support member, with the support members being mounted across a base in a horizontally and vertically spaced relationship relative to each other.

In light of our above determination, we cannot agree with the examiner that Preller teaches structure that corresponds to the structure (two attachment members, each with one or more brackets) described and claimed by appellant.

The examiner appears to have alternatively concluded (answer, page 3) that Preller teaches an equivalent of the aforementioned attachment member structure described by appellant. We note that an equivalent can result from an insubstantial change which adds nothing of significance to a structure disclosed in a specification. See Valmont Industries Inc. v. Reinke Mfg. Co. Inc., 983 F.2d 1039, 1043-44, 25 USPQ2d 1451, 1455 (Fed. Cir. 1993). However, we do not perceive from the teaching of Preller structure which denotes an insubstantial change (an equivalent) of the two attachment members, each with one or more brackets, described and claimed by appellant.

RECOMMENDATION

In accordance with 37 CFR § 1.196(d), we recommend that the examiner reject claim 11, objected to but otherwise considered allowable, under 35 U.S.C. § 112, second paragraph,

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as being indefinite. The word "preferably", in the context in which it is used in the claims, infers that the limitation set forth in the claim may or may not be a positively recited part of the claimed frame structure. As such, the scope and content of this dependent claim is indeterminate, i.e., the metes and bounds of the claimed invention cannot be fairly determined. We remand this application to the examiner for consideration of this matter.

Pursuant to the provisions of 37 CFR § 1.196(d), the application is remanded to the Primary Examiner for consideration of the above ground of rejection of allowed claim 11. A period of two months is set in which the appellant may submit to the Primary Examiner an appropriate amendment, or a showing of facts or reasons, or both, in order to avoid the ground of rejection of the identified allowed claim.

Upon conclusion of the proceedings before the Primary Examiner on remand, this case should be returned to the Board by the Primary Examiner so that the Board may either adopt its decision as final or render a new decision on all of the claims on appeal as it may deem appropriate. Such return is unnecessary if the application is abandoned as the result of an unanswered Office action, allowed or again appealed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

The decision of the examiner is reversed.

REVERSED AND REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
WILLIAM E. LYDDANE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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